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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PRG Parking Management, L.L.C.

Serial Nos. 76396894 and 76396895

Anthony J. McShane, Lee J. Eulgen and Sarah E. Smith of Neal, Gerber & Eisenberg for PRG Parking Management, L.L.C.

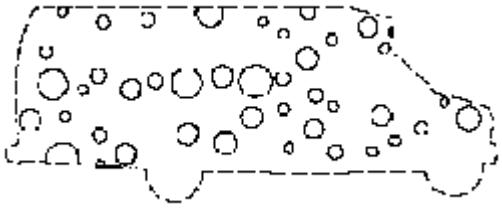
Teresa Rupp, Trademark Senior Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Hairston, Walters and Chapman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

PRG Parking Management, L.L.C. has filed two applications to register on the Principal Register two marks, both of which are represented by the same drawing shown below, and both of which are for "providing shuttle van transport service between parking lots and airport terminals; rental of car parking spaces; rental of vehicle parking spaces; parking lot services; rental of parking

spaces" in International Class 39.[1] The difference between the marks in the two applications is the claim and description of color in Application Serial No. 76396894.



The Trademark Senior Attorney (Senior Attorney) has issued a final refusal to register in each application, under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the ground that the subject matter in each application does not function as a mark in connection with the identified services.[2]

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[1] Both applications were filed April 18, 2002, based on use of the marks in commerce, alleging first use and use in commerce as of May 24, 2000. The mark in application Serial No. 76396894 is described, as amended, as follows:

> The mark consists of the trade dress of a parking shuttle, comprising contrasting circles interspersed over the surface of the shuttle. The configuration of the shuttle shown in broken lines serves to show placement of the mark only, and no claim is made to the overall design of the shuttle. **The linings are features of the mark and do not indicate color**. [Emphasis added.]

The mark in application Serial No. 76396895 is described, as amended, as follows:

> The mark consists of the trade dress of a parking shuttle, comprising the overall color yellow and a series of black circles appearing thereon. The configuration of the shuttle shown in broken lines serves to show placement of the mark only, and no claim is made to the overall design of the shuttle. **The colors yellow and black are claimed as features of the mark**. [Emphasis added.]

[2] For clarity of the record, we note that neither application contains a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). Therefore that issue is not before us.

Applicant has appealed. Both applicant and the Senior Attorney have filed briefs, but an oral hearing was not requested. Because the issues are essentially the same with respect to the two identified applications, we have addressed the refusals together in a single decision herein. We reverse the refusal to register in each application.

The Senior Attorney contends that the subject matter of application Serial No. 76396894 consists solely of circles used over the entire surface of a vehicle; that the circles are common geometric shapes which are not a background design, and, as such, this design is not inherently distinctive; and that the subject matter of application Serial No. 76396895 is not inherently distinctive for the same reasons because it consists solely of black circles and the color yellow used over the entire surface of a vehicle. She characterizes the subject matter of the two applications as “repetitive designs,” and contends that such designs are usually ornamental and not inherently distinctive.

The Senior Attorney submitted pictures of three third-party uses of color, wording and design on vehicles to establish that “it is common to ornament shuttle vans with single or multiple colors; and she contends that applicant “has chosen black circles instead of pure color to ornament its van, [and that] the use of the non-distinctive color black and the common geometrically shaped circles is not so

striking or unusual as to be inherently distinctive." Brief, p. 5. Citing *In re E.S. Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992), the Senior Attorney contends that the mere fact that applicant may be the only business to use these designs for these services does not lead to the conclusion that the designs are "unique" such that they are inherently distinctive.

On the other hand, applicant maintains that the trade dress involved in each application is inherently distinctive and only incidentally ornamental. Applicant submitted examples of its advertising and promotional materials, which show the design elements of the subject matter herein, and contended that this evidence of promotion of its designs in connection with the identified services supports a finding that the designs function as marks. Applicant pointed to its use of the word mark "The ParkingSpot" on its vehicles and in its advertising, as shown in the record, and contends that the word "Spot" in the mark "cleverly puns the spotted nature of applicant's designs" and "reinforce[s] the notion that applicant's design[s] serve as identifier[s] of source." Brief p. 6. Applicant relied on a number of cases that it contends are analogous.

The Senior Attorney objected to the relevance of the applicant's advertising and promotional materials, showing use of the same circle design and colors, submitted by

applicant as evidence of the inherent distinctiveness of the designs. She contends that this evidence is relevant only to the question of acquired distinctiveness, which is not before the Board. We agree with the Senior Attorney that this evidence is principally relevant to the issue of acquired distinctiveness. However, it is admissible evidence that we have considered, although it is of limited probative value.

We agree with the Senior Attorney's objection to the third-party registrations and other evidence not previously of record that accompanied applicant's brief on the ground that such evidence is untimely. Applicant did not comply with the established rule that the evidentiary record in an application must be complete prior to the filing of the notice of appeal. See 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Thus, this evidence has not been considered.

Turning to our consideration of the subject matter before us, we note that the term "trademark," as defined in the relevant part of Section 45 of the Trademark Act, 15 U.S.C. §1127, means "any word, name, symbol, or device, or any combination thereof used by a person to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

Clearly, not every word, combination of words, or design which appears on an entity's goods or in connection with its services functions as a mark. *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987). To be a mark, the designation must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods.

A critical element in determining whether a term or design is a trademark or service mark is the impression the term or design makes on the relevant public. In the case before us, the inquiry is whether each of the designs sought to be registered would be perceived as a source indicator, i.e., as inherently distinctive, or, rather, as merely an ornamental design on shuttle vehicles used in connection with the identified services.

Designs or symbols that are inherently distinctive are registrable without proof of acquired distinctiveness, whereas those that do not possess inherent distinctiveness can achieve status as registrable trademarks only upon proof that they have become distinctive. *Wiley v. American Greetings Corp.*, 762 F.2d 139, 26 USPQ2d 101 (1st Cir. 1985). An inherently distinctive mark is one that is "by its very nature distinctive or unique enough to create a commercial impression as an indication of origin …." *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979). While a design may

in fact be unique*, i.e.,* it may be the only such design being used by anyone, in order to be registrable as a trademark, it also must possess an "original, distinctive and peculiar appearance." *In re McIlhenny Co.,* 278 F.2d 953, 126 USPQ 138, 140 (CCPA 1960), quoting with approval from *Ex parte Haig & Haig, Ltd.*, 18 USPQ 229, 230 (Asst. Commr. 1958). The fact that other similar products use or incorporate designs which differ in only insignificant respects leads to the conclusion that such designs lack inherent distinctiveness, and thus, to be entitled to registration, they must have acquired distinctiveness as indications of the sources of the goods. *In re E. S. Robbins Corp*., 30 USPQ2d 1540 (TTAB 1992). "[A] design which is a mere refinement of a commonly adopted and well known form of ornamentation for a class of goods would presumably be viewed by the public as a dress or ornamentation for the goods." *In re Soccer Sport Supply Company, Inc*., 507 F.2d 1400, 184 USPQ 354, 347 (CCPA 1975), citing *In re General Tire & Rubber Co*., 56 CCPA 867, 404 F.2d 1396, 160 USPQ 415 (CCPA 1969).

The records in the applications before us show three other shuttle companies' vans. In two examples, the top and bottom halves of the vans are contrasting colors, and there is writing on the vans' sides in a third color. In the third example, the van is a solid color with writing and a

detailing line on its sides in a contrasting color. These examples demonstrate common techniques for ornamenting and showing advertising on shuttle vans. However, in this very fact-specific determination, we find the design of the multi-sized circles over the entire surface of a shuttle van, even more so in the application where black and yellow are claimed, to be quite different from the Senior Attorney's examples. The designs in these two applications are original, distinctive and very peculiar in nature. Also, they appear to be completely arbitrary in relation to shuttle van transport and related services. We conclude that in each application, the subject matter is an inherently distinctive mark because it is by its very nature distinctive or unique enough to create a commercial impression as an indication of origin.

Decision: The refusal under Sections 1, 2, 3 and 45 of the Act is reversed in each application.